

REMARKS

The Amendments

Claim 1 is amended for clarification purposes, as discussed below. The amendments do not narrow the scope of the claims. The amendments should not be interpreted as an acquiescence to any objection or rejection made in this application.

To the extent that the amendments avoid the prior art or for other reasons related to patentability, competitors are warned that the amendments are not intended to and do not limit the scope of equivalents which may be asserted on subject matter outside the literal scope of any patented claims but not anticipated or rendered obvious by the prior art or otherwise unpatentable to applicants. Applicants reserve the right to file one or more continuing and/or divisional applications directed to any subject matter disclosed in the application which has been canceled by any of the above amendments.

The Rejection Under 35 U.S.C. § 112, First Paragraph

The rejection under 35 U.S.C. § 112, first paragraph, is respectfully traversed.

The objection to the terms aryl and aralkyl remains and it is stated that the specification does not provide enablement for R⁴ and R⁵ being any aryl or C₇₋₂₀ aralkyl group. However, in the last amendment, claim 1 was amended to recite specific definitions of the terms aryl and aralkyl; see the two paragraphs following the recitations of R⁴ and R⁵ specifically reciting in the claim the meaning of aryl and aralkyl terms for the R⁴ and R⁵ groups. It was believed that such clarification rendered the grounds of rejection moot. It appears that possibly the amendment was overlooked since the Office Action fails to mention the amendment or give any indication of why it does not overcome the rejection. The rejection appears to be based on the allegation that the specification does not support any and

all aryl or aralkyl groups for R⁴ and R⁵ but it is clear that the literal recitations of the claims only relate to specifically identified aryl and aralkyl groups which are clearly set forth in the disclosure.

The claims are not overly broad as each R group is literally defined by a small number of specific groups. In any event, breadth alone is not a sufficient basis for rejection. Although the citation to Wands is appreciated, In re Marzocchi et al., 169 USPQ 367 (CCPA 1971), which specifically addressed the burden of proof upon the Patent and Trademark Office (PTO) must also be considered. In order to support a rejection under 35 U.S.C. § 112, first paragraph, for lack of enablement, the burden lies first with the PTO to provide evidence or objective reasoning substantiating the allegation that the enabling disclosure is not commensurate in scope with the claims. As stated in Marzocchi,

“.. a specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented *must* be taken as in compliance with the enabling requirement of the first paragraph of § 112 *unless* there is reason to doubt the objective truth of the statements contained therein..”,

and further,

“.. it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain *why* it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement.” (emphasis original).

The outstanding rejection provides no explanation why it doubts applicants' clear statements in the specification on making and using the claimed compounds, which statements are clearly applied to the whole claims' scope. And certainly the rejection provides no evidence or reasoning as to why the currently claimed compounds could not be

made or used by one of ordinary skill in the art using reasonable experimentation based on the knowledge in the art.

For all of the above reasons, it is urged that the rejection under 35 U.S.C. § 112, first paragraph, be withdrawn.

The Rejection Under 35 U.S.C. § 112, Second Paragraph

The rejection of claims 1-20 under 35 U.S.C. § 112, second paragraph, is believed to be rendered moot at least in part by the above amendments. The claims are amended in several respects in the manner suggested in the Office Action to better conform to U.S. practice.

As to the stereoisomers term, it appears the rejection is based on the recitation of mixtures thereof. Although applicants do not believe this recitation creates any indefiniteness, the mixtures term is removed to moot the rejection. This should not be seen as any limitation of the claims' scope.

As to the R⁶ and R⁷ together being an oxygen atom recitation, it was believed, as pointing out in applicants' last Reply, that the meaning was clear since the only possible structure from R⁶ and R⁷ together being an oxygen atom is an epoxide group. Carbonyl is not possible since the R⁶ and R⁷ originate from different carbon atoms. However, the claim is now amended to make perfectly clear the result when the groups are combined.

For the above reasons, it is urged that the rejection under 35 U.S.C. § 112, second paragraph, should be withdrawn.

It is submitted that the claims are in condition for allowance. However, the Examiner is kindly invited to contact the undersigned to discuss any unresolved matters.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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